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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,727	01/31/2001	Martha L. Lyons	10007376-1	6080

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

CORRIELUS, JEAN M

ART UNIT	PAPER NUMBER
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2162

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/774,727

Applicant(s)

LYONS, MARTHA L.

Examiner

Jean M Corrielus

Art Unit

2162

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: _____.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: (See Attached).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s).
13. ☐ Other: _____.


Jean M Corrielus
Primary Examiner
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ADVISORY ACTION

1. This office action is in response to the request for consideration filed on March 23, 2005, in which claims 1-20 are presenting for further examination.

Remark

(A). Applicants asserted that the examiner has failed to meet his burden of proof and has, thus, failed to establish a prima facie case of obviousness by failing to meet at least one of the three basic criteria set forth in the MPEP section 2142.

(i) Prima Facie Case.

The examiner kindly submits that the Applicant misread the applied references. However, when read and analyzed in light of the specification, the invention as claimed does not support applicant's assertions. Actually, applicants are interpreting the claims very narrow without considering the broad teaching of the references used in the rejection. In the last office action, the examiner went through the claims phrase by phrase and referred to the prior art column and line number as to where he has drawn the correspondences between applicant's claims phrases and prior art. Applicant has failed to show how the languages of the claims are different from the prior art used in the rejection. In fact, the Applicant repeatedly argued that the examiner has failed to meet the burden of proof. The examiner has provided substantial evidence as to where each limitation of the Applicant's claimed is taught in the reference. It is not clear what burden of proof the Applicant is referred to. The Applicant has not provided any evidence that convincingly show that the examiner's references do not meet the claims language. In other word, the Applicant has failed to rebut the examiner's prima facie case of obviousness uses for a different purpose which does not alter the conclusion that its use

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in a prior art device would be prima facie obvious from the purpose disclosed in the reference. Furthermore, Applicant is reminded that 37 CFR 1.111(b) states, “a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirement of this section”. Thus, applicant’s assertions are just mere allegation with no supported fact by failing to specifically point out how the language of the claims patentably distinguished them from the cited references.

(ii). Motivation to Combine the References

Applicants cite numerous court decisions in supporting his allegation that the motivation is neither found explicitly in the references nor suggested to one of ordinary skill in the art. with to no motivation to combine. The Court, In re Fritch, stated “the examiner can satisfy the above mentioned assertion only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references”. In re fine, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (Citing In re Lalu, 747, F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988), each applied reference does not expressly suggest combination with the other respective references. The examiner has shown why it would have been obvious one having ordinary skill in the art to combine the teachings of Lang with Coueignoux. It is respectfully submitted that an explanation based on logic and sound scientific reasoning of one ordinarily skilled in the art at the time the invention that support a holding of obviousness has been adequately provided by the motivations given by the examiner in the prior office action. Ex parte Levengood, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93), specially every reference relies to some

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extent on knowledge of persons skilled in the art to complement that which is disclosed therein. It is respectfully submits that one having ordinary skill in the art would have found it obvious to combine the teachings of the cited references, wherein the automated reputation service provided therein (see Lang's fig.2, item 44) would incorporate the use of "transmitting a reputation information in responsive to an authorization received from said verified associated user" in the same conventional manner as disclosed by Coueignoux (col.6, lines 46-54, lines 59-63). Lang and Coueignoux, both are from the same field of endeavor. Therefore, one having ordinary skill in the art would have found it motivated to utilize such a combination in order to exploit information such as confidential information from a user while securing the information from unauthorized publication and transmitting such a confidential information only in response to authorization by the user (col.6, lines 46-54, lines 59-63). Applicant is reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. Therefore, the combination of Lang and Coueignoux is proper.

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B. *Non-Analogous Art***(iii). Coueignoux is Nonanalogous to the claimed Invention.**

In response to applicant's argument that Coueignoux is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). The aforementioned assertions, wherein the Coueignoux reference is not within the same endeavor as the claimed invention, was unsupported by objective factual evidence and was not found to be substantial evidentiary value. It is respectfully submitted that Coueignoux discloses a system for exploiting information such as confidential information from a user while securing the information from unauthorized publication and transmitting such a confidential information only in response to authorization by the user (col.6, lines 46-54, lines 59-63), similarly to the claimed "transmitting a reputation information in responsive to an authorization received from said verified associated user".

(iv). As per Applicants' arguments that all claim limitations be taught or suggested by the prior art, Applicants appear to misinterpret the guidance given under MPEP 2142. In particular, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

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There are numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions *In re Delisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1596, 1598 (Fed. Cir. 1988) (Citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined *In re Lamberti et al.*, 192 USPQ 278 (CCPA) that:

- (a) obviousness does not require absolute predictability;
- (b) non-preferred embodiments of prior art must also be considered; and
- (c) the question is not express teaching of references, but what they would suggest.

(C). According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement, that which is disclosed therein.

Furthermore, the skilled artisan would not consider the prior art embodiments in a vacuum, but would have had the motivation to combine the advantageous features of the prior art in the manner purported by the examiner for the reasons and motivations given above as well as in the prior office action. Thus the combined teachings of Lang and Coueignoux when considered as a whole to one of ordinary skill in the art make obvious that Applicants dispute.



JEAN M. CORRIELLUS
PRIMARY EXAMINER